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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/339,698	06/24/99	RICH	B D1005/192221

023370
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MM42/0216

EXAMINER

COLILLA.D

ART UNIT

PAPER NUMBER

2854

4

DATE MAILED: 02/16/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/339,698

Applicant(s)
Rich et al.

Examiner
Dan Colilla

Group Art Unit
2854



☒ Responsive to communication(s) filed on Jun 24, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 16-23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 16-23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Jun 24, 1999 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Information Disclosure Statement

1. The last item listed on applicant's IDS submitted on 12/13/99 has a patent number and inventor that do not match. In addition, the patent number listed does not appear to have any relevance to the claimed invention. It appears that applicant has intended to list the patent number 2,812,957 instead of the listed 2,812,975. The examiner has listed the former on the IDS and has additionally considered this patent.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "ply B" (found in page 15, line 11). Correction is required.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 140, 142, 144, 146, 148, 150 (shown in Fig. 2), 240 (shown in Fig. 3) and all the reference numerals at the bottom of Fig. 7 beginning with 474 and up. Correction is required.

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4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "220" has been used to designate both drops (mentioned on pg. 22, line 27 and shown in Fig. 5) and another structure in Fig. 3 that is not mentioned in the specification. Correction is required.

Claim Objections

5. Claims 17-23 are objected to because of the following informalities:

Applicant has used the term "may" throughout these claims. This term renders the claims unclear because it is not known if the limitations following the term are required by the invention or not. Appropriate correction is required.

Additionally, in claim 17, the phrase "high resolution" is vague because this is a comparative term without any basis of comparison. In other words, the fields on the game pieces have "high" resolution compared to what?

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 16-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 16, line 9, the phrase "whereby the resulting promotional game pieces may be printed in a manner that is not repetitive" renders the claim unclear because this language appears to directly contradict the phrase "using a repetitive printing process" in lines 4-5 of the claim.

In claim 17, the phrases "categorical in nature" and "conditional in nature" are unclear. These terms are so broad that they could include just about any kind of information depending on one's point of view and thus render the claims indefinite.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 16 is rejected under 35 U.S.C. 102(b) as being anticipated by Goldman et al.

Goldman et al. discloses a method for printing promotional game pieces (Goldman et al., col. 1, lines 14-24) which includes the steps of printing a first type of indicia in a repetitive process as is disclosed in col. 15, lines 47-65 of Goldman et al. Here Goldman et al. describes a first indicia,

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the game piece layout and design. This is printed using an offset press. A second indicia, game data, is printed using a computer printer 59 (Goldman et al., col. 16, lines 18-21). Prediction of outcome of the game is prevented by the shuffling of lottery numbers (Goldman et al., col. 9, lines 5-9) and the foil leaf stamping operation (Goldman et al., col. 16, lines 33-42) which hides the lottery numbers.

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts.

With respect to claim 17, Roberts discloses a method for printing promotional game pieces including two fields of printing. Figure 2A of Roberts shows a ticket that includes a repetitive printing process including printing fields such as the game name "FIVE PLAY LOTTO" and categories labeled "YOUR LUCKY NUMBERS," "INSTANT JACKPOT" and "MYSTERY NUMBERS." A second printing process includes printing a field of variable (and conditional) information consisting of "lucky" numbers 26a and 26b (Roberts, col. 4, lines 43-50) using printer 19 as shown in Figures 1 and 2C. These numbers are printed in registry with the fields of repetitive printed information as is shown in the Figures of Roberts. With respect to applicant's recitation of "high resolution" printing, applicant has not provided a basis of comparison for defining "high resolution" but it would have been obvious to use any level of resolution based on the desired level of clarity. Roberts renders the claimed invention obvious.

With respect to claim 23, Roberts discloses printing the numbers 26a and 26b with an ink jet printer (Roberts, col. 5, lines 47-60).

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11. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts as applied to claims 17 and 23 above, and further in view of Behm et al.

Roberts discloses the claimed method of printing a promotional game piece except for the benday printing. However, Behm et al. teaches a method of printing a promotional game piece including printing categorical fields 30A-30D in a repetitive process (since these would be the same for each ticket printed) and conditional fields 20. Behm et al. further teaches printing benday fields 16 and 18 as shown in Figure 2. These fields all intersect in the same area on the ticket as is shown in Figure 2 of Behm et al. It would have been obvious to combine the teaching of Behm et al. with the method of printing a promotional game piece as disclosed by Roberts for the advantage of the additional security that the benday field provides.

12. Claims 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts as applied to claims 17 and 23 above, and further in view of Sillars.

With respect to claims 19 and 21, Roberts discloses the claimed method of printing a promotional game piece except that it is not known to the examiner what type of printing is used to print the repetitive field process. However, Sillars teaches printing promotional game pieces using flexographic or offset printing (Sillars, col. 5, lines 33-35). It would have been obvious to combine the teaching of Sillars with the method of printing disclosed by Roberts for the advantage of high speed and multicolor printing.

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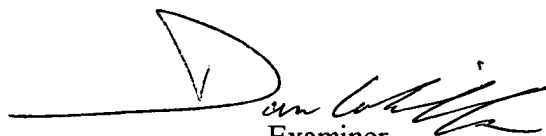
13. Claims 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts in view of Behm et al as applied to claim 18 above, and further in view of Sillars.

With respect to claims 20 and 22, Roberts in view of Behm et al. discloses the claimed method of printing a promotional game piece except that it is not known to the examiner what type of printing is used to print the repetitive field process. However, Sillars teaches printing promotional game pieces using flexographic or offset printing (Sillars, col. 5, lines 33-35). It would have been obvious to combine the teaching of Sillars with the method of printing disclosed by Roberts in view of Behm et al. for the advantage of high speed and multicolor printing.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Colilla whose telephone number is (703) 308-2259. The examiner can normally be reached M-F, 8:30-5:30. The fax number for this art unit is (703) 308-5841.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hilten, can be reached at (703) 308-0719. The receptionist for Technology Center 2800 can be reached at (703) 308-0956.

February 11, 2000


Examiner
Dan Colilla